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In re application of :
Kalyanaraman Ramnarayan et al. :
Serial No. : 09/709,905 : DECISION ON PETITION
Filed : November 10, 2000 :
Attorney Docket No.: 24737-1906C :

This is in response to applicants' petition, filed August 14, 2003 under 37 CFR 1.181, requesting withdrawal of the examiner's holding that the amendment filed June 3, 2003 was not responsive to the Office action of December 2, 2002. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed as a continuation in part of application 09/438,566 and as a continuation in part of application 09/704,362, filed November 10, 1999 and November 1, 2000, respectively. The application as filed contained claims 1-67 and a preliminary amendment added claims 68-94. In a first Office action mailed August 7, 2002, the examiner set forth a restriction requirement under 35 U.S.C. 121 dividing the claims into 9 groups. In the response filed September 6, 2002, applicant elected without traverse Group I, claims 1-25, 45-50, 66, 67 and 97-90, drawn to a method of designing drugs that act on polymorphic proteins. On December 2, 2002 the examiner mailed an Office action rejecting all the elected claims.

Applicants filed a response on June 3, 2003. The response included amendments to the claims and added claims 95-127. On July 2, 2003 the examiner mailed a Notice of Non-Responsive Amendment which indicated that none of the amended claims were drawn to the originally elected invention. The examiner stated that the original claims required *ab initio* determination of protein structure, and that the amendment had deleted this limitation from the claims.

DISCUSSION

In the petition, Applicants argue that the original claims were not limited to *ab initio* methods and further argue that *ab initio* methods are still encompassed by the amended claims.

MPEP 821.03 states, in part:

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive.

The amended original claims and the added claims still clearly encompass methods requiring *ab initio* structure determination. Therefore the examiner's determination that the amendment was non-responsive was in error.

However, applicants are reminded of the provision of 37 CFR 1.145:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

If the examiner concludes that the originally elected claims were limited to *ab initio* methods, and that the claims now include other, independent and distinct methods, the claims may be subject to election by original presentation.

DECISION

Applicant's petition is **GRANTED** for the reasons set forth above.

The Office letter of July 2, 2003 is **VACATED**.

The application will be forwarded to the examiner for consideration of the amendment filed June 3, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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